

*Atty Dkt.: 2002-IP-009930U1 (1391-41400)*

*Patent*

## REMARKS/ARGUMENTS

### *Status of Claims*

Claims 1, 29 and 46 have been amended.

Claims 25, 32, 47, and 48 have been canceled.

As such, claims 1-24, 26-31, and 33-46 are pending in this application.

Applicants hereby request further examination and reconsideration of the presently claimed application.

### *Abstract*

The abstract has been amended to delete the phrase "are disclosed."

### *Allowable Subject Matter*

Applicants note with appreciation that claims 9 and 10 would be allowable if rewritten in independent form.

### *Claim Rejection – 35 USC §102*

Claims 1-3, 5, 8, 11-16, 18, 20-22, 24, 28-32, 34, 37-44, and 46-48 stand rejected under 35 USC § 102(b) as being anticipated by *Nobileau* (US 5,337,823). Applicants have amended independent claims 1 and 46 to recite "removing the carrier from the wellbore" and claim 29 to recite a "removable carrier," which are limitations incorporated from dependent claim 25. Given that claim 25 was not rejected as anticipated by *Nobileau*, Applicants respectfully submit that the 102 rejections over *Nobileau* have been overcome by the amendments.

### *Claim Rejection – 35 USC §103*

Claim 4 stands rejected under 35 USC § 103(a) as being obvious over *Nobileau* in view of *Song* (US 5,833,001). Claims 6, 7, 35, and 36 stand rejected under 35 USC § 103(a) as being obvious over *Nobileau* in view of *Whanger* (US 6,834,725). Claims 17, 19, and 23 stand

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rejected under 35 USC § 103(a) as being obvious over *Nobileau* in view of *Kalman* (US 2004/0144535). In view of the amendment of the independent claims to incorporate the subject matter of dependent claim 25, Applicants respectfully submit that these rejections collectively stand or fall with the following rejection of claim 25.

In view of the amendments, the pending claims stand rejected under 35 USC § 103(a) as being obvious over *Nobileau* in view of *Bertet* (US 5,695,008). Applicants respectfully submit that the prior art of record does not establish a *prima facie* case of obviousness as to the pending claims. According to MPEP 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Similarly, the fact that the Examiner has the burden of proof with respect to the elements of the *prima facie* case of obviousness is also well defined in MPEP 2142:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The Examiner has not met the burden of establishing the *prima facie* case of obviousness because the combination of *Nobileau* and *Bertet* (assuming that such is proper without conceding same) does not teach or suggest all the claim limitations nor does such combination provide a reasonable expectation of success.

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Referring to paragraph 12 of the office action, the Examiner's position is that the outer envelope 7 of *Nobileau* is the same as Applicants' carrier and that the inner tubular sleeve 3 that includes braided threads 5 is the same as Applicants' sleeve. Further, in paragraph 9 of the office action, the Examiner states that "*Nobileau* discloses all of the limitations of the above claims except for releasing the sleeve from the carrier and removing the carrier from the wellbore." The Examiner further relies upon *Bertet* as teaching releasing and removing the carrier. Thus, the Examiner's position is that *Bertet* teaches that the outer envelope 7 of *Nobileau*, which the Examiner regards as the carrier, can be released and removed from the wellbore. Applicants respectfully traverse this reading of the art.

As noted in the previous response dated June 21, 2005, Applicants respectfully submit that the Examiner's reading of *Nobileau* as teaching a carrier and sleeve is improper. However, in an effort to resolve this matter, Applicants have amended the independent claims to expressly recite that the carrier is removed or removable from the wellbore, as was previously recited in dependent claim 25. Such amendment now clearly distinguishes Applicants' removable carrier from the outer envelope 7 of *Nobileau*. Specifically, the outside envelope 7 of *Nobileau* is part of the casing, which by definition stays in the well and is not removed there from. Furthermore, given that the outer envelope 7 is an integral part of the casing wall, one could not reasonably expect success in removing this part of the casing (assuming that such is suggested by *Bertet*, as stated by the Examiner). In fact, such a modification of *Nobileau* would render the casing unsatisfactory for its intended purpose of casing a wellbore. According to MPEP 2143.01, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." Given that *Nobileau* does not teach or suggest each and every element recited in the pending claims, and likewise that a modification of *Nobileau* as suggested by the Examiner renders the prior art

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unsatisfactory for its intended purposes, Applicants respectfully submit that the pending claims are patentable over the art of record.

**No Further Search Required**

Applicants respectfully direct the Examiner's attention to the fact that the amendments to the claims incorporate the subject matter of dependent claim 25, which the Examiner has already searched. Thus, the amendments to the claims do not require that the Examiner perform additional searching in order to consider the patentability of such at this time.

*Atty Dkt.: 2002-IP-009930U1 (1391-41400)**Patent***CONCLUSION**

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Final Office Action dated July 28, 2005 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.


Respectfully submitted,

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9-27-05

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